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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,476	10/30/2001	Gilbert Moineau	SWA-002-US	8087
7590	02/23/2005		EXAMINER	
Piper Marbury Rudnick & Wolfe 1200 Nineteenth Street NW Washington, DC 20036-2412			REFAI, RAMSEY	
			ART UNIT	PAPER NUMBER
			2154	

DATE MAILED: 02/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/830,476	MOINEAU ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Ramsey Refai	2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 30 October 2001.  
 2a) This action is FINAL.                            2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-21 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-21 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date 3/5/02

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_

## **DETAILED ACTION**

1. Claims 1-21 are presented for examination.

### ***Claim Objections***

2. Claim 4-11 and 17-21 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims 4-11 and 17-21 have not been further treated on the merits.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claim 11 is rejected under 35 U.S.C. 101 because it is directed to non-statutory subject matter as being drawn to a program per se. Programs per se are not one of the statutory classes of invention. Programs must be tangibly embodied on a computer readable medium and be drawn to a practical application in order to be eligible for patent protection.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-3 and 12-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Bhatia et al (U.S. Patent 6,023,724).

7. As per claim 1, Bhatia et al teach a network modem device configuration system connected to a modem via a local network, the system comprising:

a first module sending a request on said local network to said modem to obtain identification and static IP address data from said modem (**column 24, lines 51-59; workstation inquires address of modem**)

a second module receiving a response from said modem and displaying said static IP address (**column 4, line 45 – column 5, line 10; user interface displays network configuration data**),

a third module accepting user input to set said static IP address (**column 4, line 45 – column 5, line 10; user can configure modem**), and

a fourth module sending a request on said local network to said modem to set said static IP address (**column 24, line 44-column 25, line 9; modem stores IP address**).

8. As per claim 2, Bhatia et al teach a fifth module testing said static address on said network and, when said testing fails to validate operation of said static address for said modem, preventing said fourth module from sending the request on said local network to said modem to

set said static IP address, and one of displaying an error message and prompting said user to input new data for said static address (**column 4, line 45-column 5, line 10, column 18, lines 28-36, column 36, lines 3-6, column 37, line 3-18, and column 48, lines 15-55**).

9. As per claim 3, Bhatia et al teach said first module sends a broadcast discover message on said local network to said modem to solicit a response identifying said modem, said second module receiving and decoding a response from said modem to obtain said identification and static IP address, and said fourth module broadcasts on said local network to said modem a message including said identification of said modern and an identification of said set static address (**column 36, line 21-column 37, line 40, column 24, line 15-column 25, line 4**).

10. As per claim 12, Bhatia et al teach a method for initializing a static IP address of a network modem device on a local network, comprising the steps of broadcasting a request from a configuration station onto said local network (**column 24, lines 51-59; workstation inquires address of modem**); receiving a response to said request from said configuration station from said network modem device comprising an identification for said network modem device, said identification comprising at least an IP address for said network modem device (**column 24, lines 15-67**); verifying a compatibility of said identification with settings for said local network (**column 4, line 35 – column 5, lines 10**);

if said identification is compatible with said settings, send a confirmation message with said identification to said network modem device and receive a confirmation response from said network modem device (**column 48, lines 15-55 and column 18, lines 20-41**);

if said identification is not compatible with said settings, send a new address message comprising a new IP address for said network modem device, receive a change of IP response from said network modem device, send a new address confirmation message with said new IP address to said network modem device and receive a new address confirmation response from said network modem device (**column 18, lines 20-41 and column 24, lines 15-59**).

11. As per claim 13, Bhatia et al teach a request by said configuration station comprises a broadcast message, and said identification comprises an IP address, a MAC address and an internal DHCP server status for said network modern device (**column 4, lines 45-65 and column 6, lines 9-14**).

12. As per claim 14, Bhatia et al teach messages from said configuration station and said responses from said modem are sent on a proprietary port (**column 5, lines 15-35 and column 12, lines 44-65**).

13. As per claim 15, Bhatia et al teach a modem further comprises an integrated DHCP server, and said message sent from said modem further includes an activation status of said DHCP server (**column 6, lines 9-14**).

14. As per claim 16, Bhatia et al teach a modem automatically detects a presence of a network DHCP server on said local network and disables said integrated DHCP server when a network DHCP server is present on said local network (**column 6, lines 9-48**).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Li et al (U.S. Patent No. 6,012,088)
- b. Sawyer et al (U.S. Patent No. 6,466,986)
- c. Beser (U.S. Patent No. 6,775,276)
- d. Fijolek et al (U.S. Patent No. 6,058,421)
- e. Rodwin et al (U.S. Patent No. 5,812,819)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramsey Refai whose telephone number is (571) 272-3975. The examiner can normally be reached on M-F 8:30 - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ramsey Refai  
Examiner  
Art Unit 2154

RR  
February 22, 2005

  
JOHN FOLLANSBEE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100